

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS & AMENDMENTS

Claims 1-7, 15-23, and 28-44 were pending in this application when last examined.

Claims 1-7, 15-23, and 28-34 have been withdrawn as being drawn to a non-elected invention.

Claims 35-44 have been examined on the merits, and stand rejected.

The present amendment amends claims 35 and 44.

Claims 1-7, 15-23, and 28-44 remain pending in this application.

Applicants reserve the right to file a continuation or division application on any canceled subject matter.

Support for the definition of the non-aromatic heterocyclic group of claim 35 can be found in the Specification, for example, at page 16, lines 16-21.

Support for the added recitation “and a pharmaceutically acceptable carrier, excipient, solvent or base” in claim 44 can be found in the Specification, for example, at page 27, line 19 to page 28, line 6.

II. REJECTIONS OF CLAIM 44 UNDER 35 U.S.C. §§ 101 AND 112, FIRST PARAGRAPH

Claim 44 is rejected under 35 U.S.C. §§ 101 and 112, first paragraph, for allegedly being an improper composition claim. See Office Action, page 2, 4th paragraph.

Claim 44 has been amended to recite an “a pharmaceutically acceptable carrier, excipient, solvent or base” as suggested by the Examiner, thereby obviating these rejections.

III. OBJECTION TO CLAIM 42

Claim 42 is objected to on the basis that a method of use as an anti-inflammatory has already been elected, and only one method of use can be examined at a time. See Office Action, page 2, 7th paragraph. Applicants respectfully traverse this objection.

Claim 42 is the only method claim currently under examination. This claim is drawn to a method of manufacturing an anti-inflammatory composition, not a method of use as an anti-inflammatory. The remaining claims under examination are product claims and not method claims. The products claims are drawn to compounds and pharmaceutical compositions useful as

anti-inflammatory agents. Accordingly, there is only method of use (i.e., method of manufacturing the composition) currently under examination. Kindly consider examining the method of manufacturing the compound of claim 42 with the elected compound claims.

IV. REJECTION OF CLAIM 42 UNDER 35 U.S.C. § 103(A)

Claim 42 is rejected under 35 U.S.C. § 103(a), allegedly obvious over the state of the art regarding alchemy and the mixing compositions. See Office Action, page 2, 8th paragraph. Applicants respectfully traverse this rejection.

Claim is drawn to a method for manufacturing an anti-inflammatory agent comprising mixing the compound of claim 35 with a pharmaceutically acceptable carrier, excipient, solvent or base. The step of mixing the compound of claim 35 is an element of the method of claim 42. The novelty of the claimed method of manufacture is the compound of claim 35, and not the method of mixing.

It is well established that to establish obviousness, three criteria must be met. First, the prior art references must teach or suggest each and every element of the claimed invention. Second, there must be some suggestion or motivation in the references to either modify or combine the reference teachings to arrive at the claimed invention. Third, the prior art must provide a reasonable expectation of success.

In this case, to render the claimed method obvious, a prior art teaching must be cited that discloses each and every element of the claimed invention, namely, the compound of claim 35. However, no reference has been cited that teaches this compound. Since no reference has been cited that teaches or suggests the compound, the rejection fails to set forth a *prima facie* case of obviousness. Thus, the rejection of claim 42 under 35 U.S.C. § 103(a) is untenable and should be withdrawn.

V. REJECTION OF CLAIM 35 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 35 is rejected under 35 U.S.C. § 112, second paragraph, as purportedly being vague and indefinite. See Office Action, pages 2-3. Applicants respectfully traverse this rejection as applied to the amended claims.

The Examiner appears to object to the breadth of the claim with regard to the heterocyclic ring. Claim 35 has been amended to recite the specific non-aromatic heterocyclic group described in the Specification at page 16, lines 16-21, thereby, obviating the Examiner's concern.

In view of this amendment, the rejection of claim 35 under 35 U.S.C. § 112, second paragraph, is untenable and should be withdrawn.

VI. REJECTION OF CLAIMS 35-44 UNDER 35 U.S.C. § 112, FIRST AND SECOND PARAGRAPHS

Claims 35-44 are rejected under 35 U.S.C. § 112, first and second paragraphs, on the basis of a lack of written description, a lack of enablement, and vagueness. See Office Action, pages 3-8.

Applicants respectfully traverse this rejection as applied to the amended claims for the same reasons given immediately above.

Again, the Examiner appears to object to the scope and breadth of the claims with regard to the heterocyclic rings. Specifically, the Examiner inquires as to location of the heteroatoms in the rings. The Examiner also contends that the heterocyclic variable is not precise and definite enough to provide a clear-cut indication of the scope of the subject matter embraced.

As discussed above, the claims have been amended to recite the specific non-aromatic heterocyclic group as described in the Specification at page 16, lines 16-21. This amendment obviates the Examiner's concerns regarding the heterocyclic rings.

In view of this amendment, the rejection of claims 35-44 under 35 U.S.C. § 112, first and second paragraphs is untenable and should be withdrawn.

CONCLUSION

For at least the foregoing reasons, Applicants respectfully submit that the present patent application is in condition for allowance. An early indication of the allowability of the present patent application is therefore respectfully solicited.

If Examiner believes that a telephone conference with the undersigned would expedite passage of the present patent application to issue, he is invited to telephone the undersigned at the number below.

Respectfully submitted,

Koji HANASAKI et al.

By: Warren Cheek
Warren M. Cheek, Jr.
Registration No. 33,367
Attorney for Applicants

WMC/JFW
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250

April 27, 2004